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| 09/788,113 | 02/16/2001 | Rodney Bennett | 21532-04870 | 2853 |

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EXAMINER

CHEN, CHONGSHAN

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| ART UNIT | PAPER NUMBER |
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2172

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/788,113 | Applicant(s) BENNETT, RODNEY | |
| | Examiner Chongshan Chen | Art Unit 2172 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. The Supplemental Declarations of Rodney Bennett and J. Dale Debber and the exhibits filed on 2 March 2004 under 37 CFR 1.131 has been considered but are ineffective to overcome the Lin et al. ("Lin", 6,526,403) reference.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

Conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The supplemental declarations of Rodney Bennett and J. Dale Debber and the exhibits do not have concrete evidence demonstrating the applicant conceived the conception for automating the assembly, processing and delivery of documents. The examiner could not find evidence in either the declarations or the exhibits supporting the claim limitations, for example “transmitting the result data to a location and in a manner specified by the information request”. Therefore, the conception is not established. The affidavit is insufficient to overcome Lin according to 37 C.F.R. 1.131.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Lin et al. ("Lin", 6,526,403).

As per claim 1, Lin discloses a method for creating and delivering a document, the method comprising the steps of:

receiving an information request; acquiring data regarding the information request; extracting data using the acquired data (Lin, Fig. 3, col. 5, lines 30-32, "send queries to the local database system that will be handled by a query processing component");

applying a rule to the extracted data to produce result data (Lin, Fig. 3, col. 6, lines 41-42, "The Query Rewrite phase applies heuristic rules to rewrite the QGM structure into a more efficient form"); and

transmitting the result data to a location and in a manner specified by the information request (Lin, Fig. 1, col. 3, lines 33-67).

As per claim 2, Lin teaches all the claimed subject matters as discussed in claim 1, and further discloses formatting the information request into a work item using the acquired data (Lin, col. 6, lines 14-65).

As per claim 3, Lin teaches all the claimed subject matters as discussed in claim 2, and further discloses the work item includes one from a group of: a reference to a file; a destination for the displayable result; a transport mechanism that specifies how displayable result is to be delivered; a rendering object for performing the extracting and applying steps; a name of a server on which the rendering object is to be executed; and a priority for the work item indicating an

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order for performing the work item relative to other work items (Lin, col. 17, line 17 - col. 18, line 47).

As per claim 4, Lin teaches all the claimed subject matters as discussed in claim 2, and further discloses work item is used in the step of extracting, applying, processing and transmitting (Lin, col. 17, line 17 - col. 18, lines 47).

As per claim 5, Lin teaches all the claimed subject matters as discussed in claim 2, and further discloses wherein step of acquiring data regarding the information request includes: displaying a user interface; providing default values; receiving input for at least one field; formatting data element for queuing; assembling data elements into a work item; and adding the work item to a work queue (Lin, Fig. 1-4).

As per claim 6, Lin teaches all the claimed subject matters as discussed in claim 2, and further discloses wherein step of extracting data includes: receiving and accessing the work item; retrieving the acquired data from the work item; using the acquired data to generate a query; applying the query to the database; and storing the result of the query as part of the work item (Lin, Fig. 3, col. 6, lines 14-65).

As per claim 7, Lin teaches all the claimed subject matters as discussed in claim 2, and further discloses receiving the extracted data from a source; and applying the rule to the retrieved data by performing operations specified in a rendering object; determining whether the extracted data is in violation of the rule; and processing the work item with another rendering object if it is determined that the extracted data is in violation of the rule (Lin, Fig. 4).

As per claim 8, Lin teaches all the claimed subject matters as discussed in claim 2, and further discloses receiving the extracted data from a source; applying the rule to the retrieved

data by performing a database search and using the results of the search as parameters in the application of the rule to the extracted data; determining whether the extracted data is in violation of the rule; and processing the work item with another rendering object if it is determined that the extracted data is in violation of the rule (Lin, Fig. 4).

As per claim 9, Lin teaches all the claimed subject matters as discussed in claim 1, and further discloses receiving the result data, processing the result data to produce a displayable result; and wherein step transmitting the result data is the transmission of the displayable result adapted for the transport medium (Lin, Fig. 1, col. 3, lines 33-67).

As per claim 10, Lin discloses a system for automating the assembly, processing and delivery of documents, the system comprising:

a first module having a transport client for acquiring data and generating a work item (Lin, Fig. 3, col. 5, lines 30-32, “send queries to the local database system that will be handled by a query processing component”);

a second module for applying a business rule to the acquired data to produce result data, the second module coupled to the first module to receive the work item (Lin, Fig. 3, lines 41-42, “The Query Rewrite phase applies heuristic rules to rewrite the QGM structure into a more efficient form”); and

a third module for producing and transmitting a document from the result data, the third module coupled to the second module to receive the work item (Lin, Fig. 1, col. 3, lines 33-67).

As per claim 11, Lin teaches all the claimed subject matters as discussed in claim 10, and further discloses a fourth module for producing query data by applying the acquired data to a database, the input of the fourth module coupled to receive the work item from the first module,

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and the fourth module coupled to output the work item to the third module, and wherein the third module uses the query data as result data for producing and transmitting the document (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

As per claim 12, Lin teaches all the claimed subject matters as discussed in claim 10, and further discloses a work queue for storing work items, the work queue coupled to the first module, the second module, and the third module for receiving work items; and a scheduler coupled to the work queue for processing work items, determining the status of work items and sending work items to the second module and the third module (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

As per claim 13, Lin teaches all the claimed subject matters as discussed in claim 10, and further discloses a transport client, the transport client coupled to work queue for storing work items therein, the transport client acquiring data and creating work items from the data (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

As per claim 14, Lin teaches all the claimed subject matters as discussed in claim 10, and further discloses a rendering object, the rendering object coupled to the work queue for receiving work items from the work queue and for storing work items into the work queue, the rendering object for applying a business rule to the acquired data to produce the result data (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

As per claim 15, Lin teaches all the claimed subject matters as discussed in claim 11, and further discloses a rendering object, the rendering object coupled to the work queue for receiving work items from the work queue and for storing work items into the work queue, the rendering

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object for generating and applying a query on a database and adding query results to the work item (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

As per claim 16, Lin teaches all the claimed subject matters as discussed in claim 10, and further discloses a transport object, the transport object coupled to the work queue for receiving work items from the work queue, the transport object coupled to a corresponding delivery mechanism for sending the document, the transport object receiving a work item, converting the result data into a document suited to the delivery mechanism and transmitting the document over the delivery mechanism (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

As per claim 17, Lin teaches all the claimed subject matters as discussed in claim 16, and further discloses a routing table having information for resource allocation, resource availability, local or remote processing, and time of processing, the routing table coupled to the third module; and wherein the transport objects of the third module use the routing table to determine a time to use and type of delivery mechanism for transmitting the document (Lin, Fig. 1, col. 3, line 33 - col. 5, line 12).

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is 703-305-8319. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703)305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 2, 2004


SHAHID ALAM
PRIMARY EXAMINER